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EXAMINER

STONE, JONATHAN D

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/449,707

Applicant(s)

CONSTANTINO ET AL.

Examiner

Jonathan D Stone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment A filed on 6/13/03.
2. Claims 1-21 are pending in the case. Claims 1, 7, 13 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6-7, 9, 12-13, 15, 18, 19, and 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al (herein Luchs; USPN 4831526 – filing date 4/22/1986) in view of Hoyt et al (herein Hoyt; USPN 6067531 – filing date 7/21/1998) and in further view of Shirley et al (herein Shirley; USPN 5692206 – filing date 11/30/1994).

4. **Regarding independent claim 1**, Luchs discloses an invention for creating contracts. He discloses providing for an operator to request and supplement information upon request (col 2, ln 32-37; compare with “*an entry tool...inquiry;*”). Luchs teaches the use of common application forms (col 2, ln 26-61; compare with “*one or more model agreements;*”). Luchs teaches creating a contract document by merging stored text selected by a user upon a user’s request (col 3, ln 66 – col 4, ln 16; compare with “*a document assembler...client request;*”). Luchs also discloses storing the contract and associated data in a repository (col 4, ln 28-31; compare with “*a repository...inquiry.*”).

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Luchs does not explicitly disclose processing key date reminders and approvals and storing the associated data. However, Hoyt teaches a contract negotiator/generator that keeps track of such information and stores that information in a repository. Hoyt's invention tracks approval modifications to a document, as well as the user that made the modifications and when they were made (col 7, ln 34-38; col 12, ln 46-49; col 22, ln 56-63; and col 32, ln 61-67). The tracking information is stored in databases (col 8, ln 33-42). Additionally, Shirley teaches a contract generating invention that provides for tracking schedules, due dates, and other important dates (col 2, ln 15-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Luchs' invention to include means for tracking the approval status and important dates associated with a contract, including storing the tracking information in a repository. Such a modification would have given an agent generating a contract more flexibility. Allowing a client to fill in clauses appropriate for the client and further allowing the agent to track the document's status and associated dates would have alleviated a communication burden if negotiating was necessary. Storing the tracking information would have allowed a user to check the contract's status with requiring the contract itself to present itself to check.

5. **Regarding dependent claim 3**, Luchs does not explicitly disclose automatically sending key date reminders to a client via e-mail. However, Hoyt discloses distributing documents to users after the status of the document is changed (col 15, ln 30-35). The use of electronic mail to distribute documents throughout a network was known and typical at the time of the invention. Shirley teaches incorporating an e-mail control unit for contract distribution (col 2, ln 57-61). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify

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the tracking tool as described in the rejection of claim 1 to send documents, including tracked information like key dates, through e-mail means. Such a modification would have improved user interface and access by delivering important documents through familiar means.

6. **Regarding dependent claim 6**, Luchs does not explicitly disclose a library of supplemental provisions. However, Shirley discloses the use of additional provisions for generating contracts (col 2, ln 11-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the teaching of Shirley to the invention disclosed by Luchs. This would have given a user more opportunity for tailoring a contract to his or her needs.

7. **Regarding dependent claims 7, 9, and 12**, the claims incorporate substantially similar subject matter as claims 1, 3, and 6, respectively, and are rejected along the same rationale.

8. **Regarding dependent claims 13, 15, and 18**, the claims incorporate substantially similar subject matter as claims 1, 3, and 6, respectively, and are rejected along the same rationale. Additionally the claims include a computer readable medium. The use of a computer readable medium on which to store program instructions, program products, and other data was known and typical at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a computer readable medium in the invention described in the rejection of claim 1. This would have provided the invention with local access to program instructions to implement the invention as well as access to databases and storage areas.

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9. **Regarding dependent claims 19 and 21**, Luchs, Hoyt, and Shirley do not explicitly disclose recording a library of model agreements or supplemental provisions on a computer readable medium. However, it was known and typical at the time of the art to store libraries on a computer readable medium accessible to an application associated with said libraries. It would have been obvious to one of ordinary skill in the art at the time of the invention to store the library on a computer readable medium accessible to the current invention. This would have provided a user with easy access to the libraries.

Claims 2, 8, and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs in view of Hoyt and Shirley and in further view of "Frequently Asked Questions about Your Virtual Agent Network for World Wide Business" (herein VAN; Australian American Chamber of Commerce, 1996).

10. **Regarding dependent claim 2**, Luchs does not explicitly disclose model agreements in a plurality of languages. However, VAN teaches an invention for assisting users in buying and selling goods and negotiating the exchange of said goods. VAN discloses the use of the invention in multiple languages to cater to a global market (pg 1-2 and 16-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions disclosed by Luchs and VAN. Such a combination would have opened the use of Luchs' contract builder to a global market, instantly increasing the breadth of the invention.

11. **Regarding dependent claims 8 and 14**, the claims incorporate substantially similar subject matter as claim 2, and are rejected along the same rationale.

Claims 4-5, 10-11, 16-17, and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs in view of Hoyt and Shirley and in further view of Grubb et al (herein Grubb; USPN 5272623 – filing date 11/7/1990).

12. **Regarding dependent claims 4 and 5**, Luchs does not explicitly disclose a library of alternate clauses. However, Grubb discloses maintaining a database of Government Agency Regulation clauses (GARCs) for insertion into a contract document (col 2, ln 10-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the two inventions to create a contract document creator with more options for a user. A database of clauses would have given a user more opportunity for tailoring a contract to his or her needs.

Furthermore, sorting libraries was common and typical in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to organize the clause library by type. This would have presented a more logical organization for users to access and find what they needed in the library.

13. **Regarding dependent claims 10 and 11**, the claims incorporate substantially similar subject matter as claims 4 and 5, respectively, and are rejected along the same rationale.

14. **Regarding dependent claims 16 and 17**, the claims incorporate substantially similar subject matter as claims 4 and 5, respectively, and are rejected along the same rationale.

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15. **Regarding dependent claim 20**, Luchs, Hoyt, Shirley, and Grubb do not explicitly disclose recording a library of alternate clauses on a medium. However, it was known and typical at the time of the art to store libraries on a computer readable medium accessible to an application associated with said libraries. It would have been obvious to one of ordinary skill in the art at the time of the invention to store the library on a computer readable medium accessible to the current invention. This would have provided a user with easy access to the libraries.

Response to Arguments

16. Applicant's arguments filed 6/13/03 in Amendment A have been fully considered but are not persuasive.

17. Regarding Claim 1, Applicant argues (pg 8-9, Amendment A) that the prior art of record does not teach or suggest "one or more model agreements". However, Applicant admits that Luchs does teach predetermined paragraphs used to create insurance contracts, or agreements (pg 9, Amend. A). Luchs does not preclude the use of said predetermined paragraphs as model agreements. It was known at the time of the invention that agreements and contracts appeared in various sizes and lengths. It is not unreasonable to assert that an entire agreement or contract may have been comprised in one paragraph, such as the paragraphs taught by Luchs. Since Luchs' paragraphs are predetermined, this gives a user the opportunity to use the paragraphs as models on which to base a contract. Applicant continues with the argument by presenting an

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analogy of a room full of computer parts versus a room of model computers. However, computers appear in every shape and size. Some computers require additional peripherals or devices to function properly, and thus would require the construction of the various parts in the computer part room in order to obtain a proper computer to present in the model computer room. On the other hand, some computers don't require additional parts because the device is itself a computer independent of any additional parts attached. That computer remains the same in both the parts room and model room. For example, a calculator may be stored in the storage room along with associated parts (a device for projecting the display, additional power supply, link cable, etc.). The calculator may be shown in the model room with the extra parts attached, or by itself. Either way, the calculator is still a computer. This is keeping with the Office's argument that a paragraph taught by Luchs may be a model contract itself; the opportunity to add additional paragraphs does not negate the fact that a single paragraph may constitute an entire contract.

18. Applicant argues (pg 9-10, Amendment A) that Luchs' teaching of selecting and merging individual paragraphs to form an insurance contract (i.e. agreement) does not teach or suggest the claimed selecting and merging of model agreements. However, as argued above, Luchs' paragraphs may be model agreements themselves. In such a case, the selecting and merging of individual paragraphs would read on the selecting and merging of model agreements as claimed.

19. Applicant argues (pg 10, Amendment A) the prior art of record does not teach or suggest "a repository for storing said contract and said tracking data and for responding to the said client

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query”. The Office admits that Luchs does not explicitly teach tracking data and the storage of that tracking data. The Office contends that Luchs does teach the storage of the contract as per Luchs teaching of “the information included in the original application is electronically stored and displayed”. Hoyt, however, teaches keeping track of information associated with contracts, such as approvals, as per the rejection of claim 1 above. Hoyt teaches such information being stored in repositories (col 8, ln 33-42). When combined with Luchs it would have been obvious to one of ordinary skill in the art at the time of the invention to include a repository in which to store the tracking information associated with the contract. Not storing the information in memory would have defeated the purpose of tracking the status of the contract since the contract itself would have had to be looked at every time a status query was made.

20. Applicant argues (pg 10-11, Amendment A) the motivation for combining the prior art of record because Shirley’s use of dates essentially relates to events that will occur after the contract has been generated and Luchs’ invention is not necessarily concerned with events occurring after contract generation. However, Luchs actually does concern himself with events that occur after the generation of a contract. Specifically, Luchs teaches displaying an application (i.e. contract) for the purpose of approval/disapproval (col 2, ln 43-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Luchs with Hoyt, arriving at a more flexible contract generation system that is easier for users to use. It also would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shirley with Luchs and Hoyt, arriving at a contract generation system that maintains the general document construction method but provides a user with greater

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customization of documents and more expands on the supplemental contract-associated information provided by Hoyt.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D Stone whose telephone number is (703) 305-7854. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular

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communications and (703) 746-7238 for After Final communications. Responses to this action may be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Hand-delivered responses should be brought to:

Crystal Park II, 2121 Crystal Drive
Arlington, VA, Fourth Floor (receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

JDS
August 20, 2003


JOSEPH H. FEILD
PRIMARY EXAMINER